

REMARKS

This Application has been carefully reviewed in light of the Office Action mailed July 29, 2005. Claims 1-7 and 13-19 were pending in the Application. In the Office Action, Claims 1, 2, 4-7, 13, 14, 18 and 19 were rejected, and Claims 3 and 15-17 were objected to. In order to expedite and advance the prosecution of this Application, Applicants amend Claims 1, 7 and 13. Thus, Claims 1-7 and 13-19 remain pending in the Application. Applicants respectfully request reconsideration and favorable action in this case.

In the Office Action, the following actions were taken or matters were raised:

SECTION 102 REJECTIONS

Claims 1, 2, 5-7 and 18 were rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 5,694,315 issued to Huang et al. (hereinafter "*Huang*"). As an initial matter, Claim 18 depends from independent Claim 13. However, the Examiner has not rejected independent Claim 13 under 35 U.S.C. § 102. Accordingly, Applicants perceive the Examiner's rejection of Claim 18 misplaced. The Examiner rejected independent Claim 13 under 35 U.S.C. § 103. Therefore, Applicants assume that the Examiner meant to reject Claim 18 under 35 U.S.C. § 103, and Applicants accordingly respond. Applicants respectfully traverse the 35 U.S.C. 102(b) rejection for Claims 1, 2 and 5-7.

Of the rejected claims, Claim 1 is independent. Applicants respectfully submit that *Huang* does not disclose or even suggest each and every limitation of amended independent Claim 1. For example, Applicants respectfully submit that *Huang* does not disclose or even suggest "a template body adapted to receive a media object to be scanned" and "an element disposed on the template for generating an optical pattern when scanned" where "the optical pattern indicat[es] a particular scan routine for scanning the media object" as recited by amended Claim 1 (emphasis added).

Huang appears to disclose a frame holder having a number of "orientation holes" that generate a pattern with white circle images on a black background (*Huang*, column 1, lines 42-67, column 2, lines 1-8, figures 1-3). Thus, the "optical pattern" in *Huang* apparently referred to by the Examiner appears to be used for orientation of the scanned images ("Next, we locate the scanning area and calculate the tilt angle of each frame holder." (*Huang*, column 2, lines 39-40)(emphasis added)). In contrast, independent Claim 1 recites "the optical pattern indicating a particular scan

routine for scanning the media object” (emphasis added). Accordingly, for at least this reason, Applicants respectfully submit that *Huang* does not anticipate Claim 1.

Claims 2 and 5-7 that depend from independent Claim 1 are also not anticipated by *Huang* at least because they incorporate the limitations of Claim 1 and also add additional elements that further distinguish *Huang*. Therefore, Applicants respectfully request that the rejection of Claims 2 and 5-7 be withdrawn.

SECTION 103 REJECTIONS

Claims 4 and 9 were rejected under 35 U.S.C. 103(a) as being unpatentable over *Huang*. Claims 13 and 14 were rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,850,344 issued to Chang (hereinafter “*Chang*”) in view of *Huang*. As discussed above, Applicants assume that the Examiner meant to reject Claim 18 under 35 U.S.C. 103 because independent Claim 13, from which Claim 18 depends, was rejected under 35 U.S.C. 103 as set forth above. Thus, Applicants respond accordingly. Applicants respectfully traverse this rejection.

Claims 4 and 9 depend from independent Claim 1. At least for the reasons discussed above, independent Claim 1 is patentable over the cited reference. Therefore, Claims 4 and 9 that depend from independent Claim 1 is also patentable. Accordingly, Applicants respectfully request that the rejection of Claims 4 and 9 be withdrawn.

Of the remaining rejected claims, Claim 13 is independent. Independent Claim 13, as amended, recites “a template adapted to receive a media for scanning, the template comprising an element for generating an optical pattern when scanned in the scanner system, the optical pattern indicating a particular scan routine for scanning the media” (emphasis added). As discussed above in connection with independent Claim 1, *Huang* does not disclose or even suggest “indicating a particular scan routine” based on “the optical pattern” as recited by Claim 13. Moreover, *Chang* does not remedy at least this deficiency of *Huang*. Accordingly, neither *Chang* nor *Huang*, alone or in combination, discloses, teaches or suggests the limitations of independent Claim 13. Accordingly, Applicants respectfully submit that independent Claim 13, and Claim 14 that depends therefrom, are patentable over the cited references.

CLAIM OBJECTIONS/ALLOWABLE SUBJECT MATTER

Claims 3 and 15-17 were objected to as being dependent upon a rejected base claim. Applicants note with appreciation that the Examiner indicated that Claims 3 and 15-17 would be


allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Claim 3 depends from independent Claim 1, and Claims 15-17 depend from independent Claim 13. For at least the reasons discussed above, independent Claims 1 and 13 are in condition for allowance. Therefore, Claims 3 and 15-17 that depend respectively therefrom are also in condition for allowance, and Applicants respectfully request that the objection to Claims 3 and 15-17 be withdrawn.

CONCLUSION

Applicants have made an earnest attempt to place this case in condition for immediate allowance. For the foregoing reasons and for other reasons clearly apparent, Applicants respectfully request reconsideration and full allowance of all pending claims.

An RCE filing fee of \$790.00 is believed due. The Director of Patents and Trademarks is hereby authorized to charge Deposit Account No. 08-2025 of Hewlett-Packard Company the amount of \$790.00 to satisfy the RCE filing fee. If, however, Applicants have miscalculated the fee due with this RCE, the Director is hereby authorized to charge any fees or credit any overpayment associated with this RCE to Deposit Account No. 08-2025 of Hewlett-Packard Company.

Respectfully submitted,

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